

REMARKS

Introduction

This Reply addresses issues raised in the Restriction Requirement dated December 23, 2009. As noted above, Applicants file the present submission to remedy a typographical error on page 12 of the Reply to Restriction Requirement filed January 25, 2010 (election of Group II instead of correctly electing Group I).

Claims 1-12 are pending in this application. Claims 1-12 are subject to restriction for the reasons set forth herein.

Rejection of Claims 1-12

A. The Rejection

The Examiner alleges that restriction is required because the application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1:

Group I: Claims 1-12 drawn, in part, to compounds of formulae (I') or (II) represented by compounds of formulae (Ia) to (Iy) where T1 represents N and T2-T4 represent C and methods of treatment using these compounds;

Group II: Claims 1-12 drawn, in part, to compounds of formulae (I') or (II) represented by compounds of formulae (Iaa) and (Icb) to (Icz) where T1 represents S and T2-T3 represent C and methods of treatment using these compounds;

Group III: Claims 1-12 drawn, in part, to compounds of formulae (I') or (II) represented by compounds other than defined above for Groups I and II and methods of treatment using these compounds.

The Examiner contends that there is no common core which in the Markush practice, is a significant structural element shared by all alternatives. The Examiner contends that in the instant case, the variables p, q and ring T are critical for the common core of the instant compounds.

B. Election and Traverse

In reply, Applicants elect Group I (claims 1-12) drawn, in part, to compounds of formula (I') or (II) represented by compounds of formulae (Ia) to (Iy) where T1 represents N and T2-T4 represent C and methods of treatment using these compounds. Applicants, however, traverse the requirement for restriction for the following reasons.

The requirement of a technical interrelationship and the same or corresponding special technical features as defined in PCT Rule 13.2 are considered to be met when the alternatives are of a similar nature. See MPEP §1850. When the Markush grouping is for alternatives of chemical compounds, the alternatives are regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity; and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives; or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains. Id.

The requirement of a "significant structural element is shared by all of the alternatives" refers to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity. Id. The structural element may be a single component or a combination of individual components linked together. Id.

In paragraph (B)(2), above, the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved. Id. The fact that the alternatives of a Markush grouping can be differently classified should not, taken alone, be considered to be justification for a finding of a lack of unity of invention. Id.

With regards to the instant case, the compounds of claims 1-12 have a common property or activity, namely that of combating and controlling insects, acarines, nematodes or molluscs. A common structure is present, i.e., a significant structural element is shared by all of the alternatives based on the structure of formulas (I), (I') and (II). In support, Applicants note that the International Searching Authority, in issuing the International Preliminary Report on Patentability, considered the claims to be unified (see International Preliminary Report on Patentability dated June 12, 2006).

Additionally, the Examiner appears to be requesting a grouping that represents an arbitrary restriction unrelated to the claimed chemical compounds. In dividing up the subject matter the Examiner has failed to take account of all subject matter falling within his definitions given in the Office Action. For example; Group 1, as defined by the Examiner, is drawn to "compounds of

formula (I') or (II) represented by compounds of formula (Ia) to (Iy) wherein T1 represents N and T2-T4 represent C (pages 18 – 44 of the specification) and methods of treatment using these compounds.” The Examiner’s definitions for T1 and T2 – T4 in Group I, however, apply to compounds other than those compounds disclosed on pages 18 - 44 of the specification. For example, the compounds of formula Ibc in Table LV on page 55 of the specification fall within Group I (see WO/2005061500). Thus, such compounds should also be included in Group I based on the definitions given by the Examiner.

Applicants, therefore, respectfully request that the Examiner withdraw the restriction requirement in light of the above comments or, alternatively, reconsider the grouping to encompass a consistent group of claimed compounds.

Applicants invite the Examiner to telephone the undersigned attorney of record if the Examiner feels that the call will be beneficial to advance prosecution of the application.

Respectfully submitted,

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/Mark D. Jenkins/
Mark D. Jenkins
Reg. No. 59,566
Attorney for Applicants
Womble Carlyle Sandridge & Rice, PLLC
Post Office Box 7037
Atlanta, Georgia 30357-0037
Telephone: (919) 484-2317
Facsimile: (919) 484-2096
Customer No.: 86344